

REMARKS

Reconsideration and allowance of the above-identified application are respectfully requested. Claims 1-4, 6-13, 15-19, 22-28, and 30-45 are pending, wherein claims 1, 10, 16, 25 have been amended, claims 5, 14, 20, 21, and 29 have been cancelled, and claims 34-45 are new.

Initially, Applicants note that the Patent Office has not acknowledged consideration of the documents submitted with the Information Disclosure Statement (IDS) filed on October 25, 2004. Accordingly, submitted herewith is another copy of Form PTO-1449 submitted with the IDS that was previously filed. Applicants respectively request that the Examiner consider the documents listed on the attached Form PTO-1449, and acknowledge such consideration by returning an initialed copy of the attached form with the next communication from the Patent Office.

The Office Action rejects each of the pending independent claims (1, 10, 16, and 25) under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,351,523 to Detlef ("*Detlef*"). The Office Action rejects the dependent claims as either allegedly anticipated under 35 U.S.C. § 102(e) by *Detlef* or as allegedly being unpatentable under 35 U.S.C. § 103(a) over *Detlef* in view of either U.S. Patent No. 6,600,814 to Carter, et al. ("*Carter*") or U.S. Application Publication No. 2001/0045885 to Tett ("*Tett*").¹ For at least the forgoing reasons, these grounds of rejection are respectfully traversed.

Applicants' invention, as claimed for example in independent method claim 1, relates to composing an electronic message using a mobile device. The method includes: receiving a command to begin composing an electronic message at a mobile device; receiving a command to add audio content to the electronic message at the mobile device; diverting to a temporary storage within the mobile device, an audio content stream received at an audio input; storing the audio content stream within the mobile device in a format that is compatible with adding audio content to the electronic message; and attaching the formatted audio content to the electronic message at the mobile device. Claim 1 (similar to the other independent claims) has further been amended to include that the total amount of audio content that may be stored in temporary

¹ Although the prior art status of *Detlef*, *Carter*, and *Tett* is not being challenged at this time, applicants reserve the right to do so in the future. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status or asserted teachings of *Detlef*, *Carter*, and *Tett*.

storage is limited to a predetermined maximum, and an act of displaying a progress indicator to show a current amount of temporary storage used in storing the data audio content stream compared to the predetermined maximum.

Applicants respectfully submit that *Detlef*, *Carter*, and *Tett*, taken either individually or as a whole, do not render Applicants' claimed invention either anticipated or unpatentable for at least the reason that the cited references do not disclose or suggest each and every element of Applicants' claimed invention. For example, the combination of *Detlef*, *Carter*, and *Tett* does not disclose or suggest that a total amount of audio content that may be stored in a temporary storage is limited to a predetermined maximum, and displaying a progress indicator to show a current amount of temporary storage used in storing the data audio content stream compared to the predetermined maximum, as recited, *inter alia*, in independent claims 1, 10, 16, and 25.

Detlef discloses the management of emails originated by thin client devices by providing an email-to-voicemail gateway. As noted by the Office Action, however, *Detlef* does not disclose or suggest that the total amount of audio content that may be stored in temporary storage is limited to a predetermined maximum, and an act of displaying a progress indicator to show the amount of temporary storage used. Recognizing at least some of the deficiencies of *Detlef*, the Office Action cites *Carter*.

Carter discloses methods, apparatuses, and computer program products for reducing the load on a text-to-speech converter in a messaging system capable of text-to-speech conversion of email documents. The Office Action relies on Figures 2, 3, and col. 6, ll. 17-33 of *Carter* as allegedly disclosing the amount of text segments that may be stored in a cache or storage is limited to a predetermined maximum. The Office Action recognizes, however, that *Carter* does not contain an explicit disclosure of displaying a progress indicator to show an amount of temporary storage used. Accordingly, the Office Action citing col. 6, ll. 33-65 of *Carter* alleges that the progress indicator is inherently displayed to show a current amount of temporary storage used in storing text segments compared to a predetermined maximum, wherein the text segments are converted to speech and played back to a user of the telephone hand set.

M.P.E.P § 2112 discusses the requirements of a rejection based on inherency. This section quotes *Ex Parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) as stating that "[i]n relaying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." (Emphasis in original). M.P.E.P § 2112 also states that "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." (Emphasis in original).

Applicants respectfully note, however, that the Office Action has not provided a basis in fact, and/or technical reasoning, which would reasonably support the conclusion that the progress indicator is displayed in *Carter* to show a current amount of temporary storage used in storing text segments compared to a predetermined maximum necessarily flows from the disclosure of *Carter*. In fact, Applicants respectfully submit that *Carter* would have no use for displaying a progress indicator to show a current amount of temporary storage used in storing text segments compared to a predetermined maximum.

For example, the section of *Carter* cited by the Office Action (i.e., col. 6, ll. 17-65) discusses using a cache for storing speech signals that were previously converted to text segments that may subsequently be retrieved and played back in order to avoid the continual conversion of such segments when using a text-to-speech converter to convert new email messages to speech. As would be appreciate, this caching of speech signals is used to reduce the load on the text-to-speech converter. The cache, however, being of limited size, can only hold speech signals (or corresponding text segments) that have a length that is equal to or less then a predetermined maximum length. Those segments that are determined to have such a length are then selected for storage in the cache, whereas those that are not cannot be stored in the cache.

Carter, however, is not concerned with displaying a maximum amount of cache available. Accordingly, there can be no basis in fact, or technical reasoning, which would reasonable support a conclusion that displaying a progress indicator for the amount of cache used necessarily flows from the disclosure of *Carter*. Therefore, because *Detlef* does not disclose or suggest all of the elements of Applicants' independent claims, and because *Carter* fails to disclose or suggest, either explicitly or inherently, all of the elements of applicants independent claims, the combination of *Detlef* and *Carter* does not render these independent claims unpatentable.

Tett discloses a system and method for retrieving and displaying paging messages. The Office Action relies on *Tett* as allegedly disclosing various features and elements of the dependent claims. *Tett*, however, cannot overcome those deficiencies identified above with regard to the combination of *Detlef* and *Carter*. Accordingly, the combination of *Detlef*, *Carter*, and *Tett* does not render the independent claims unpatentable.

Based on at least the forgoing reasons, Applicants respectfully submit that the cited prior art fails to anticipate or otherwise make obvious Applicants' invention as claimed for example, in independent claims 1, 10, 16, and 25. Applicants note for the record that the remarks above render the remaining rejections of record for the independent and dependent claims moot, and thus addressing individual rejections or assertions with respect to the teachings of the cited art is unnecessary at the present time, but may be undertaken in future if necessary or desirable, and Applicants reserve the right to do so.

All of the objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance and notice to that effect is earnestly solicited. Should the Examiner have any questions regarding this response or the application in general, the Examiner is urged to contact the undersigned at (801) 533-9800.

Dated this 27th day of April, 2005.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Rick D. Nydegger", written over a horizontal line.

RICK D. NYDEGGER
Registration No. 28,651
WESLEY C. ROSANDER
Registration No. 51,030
Attorneys for Applicant
Customer No. 47973